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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 20807-0003-01							
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Art Unit 3621	Examiner F. BACKER								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>									
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 50,311 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">  Signature Shawn K. Leppo Typed or printed name _____ (717) 232-8000 Telephone number _____ February 2, 2007 Date _____ </div>							
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.									
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	AVALLONE et al.	:	Confirmation No.:	6897
		:		
Application No.:	09/828,444	:	Group Art Unit:	3621
		:		
Filed:	April 6, 2001	:	Examiner:	F. Backer
		:		
For:	METHODS AND SYSTEMS FOR PROVIDING PERSONALIZED INFORMATION TO USERS IN A COMMERCIAL ESTABLISHMENT			

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Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is filed in response to a Final Office Action dated November 2, 2006 in the above-captioned application (the "Application") in accordance with the procedures announced in the Official Gazette on July 12, 2005 as extended in the Official Gazette on February 7, 2006. A Notice of Appeal is filed concurrently herewith.

This is the third Notice of Appeal and the second request for a Pre-Appeal Brief Request for Review in this Application. The requisite fee is filed herewith.

**CONCISE STATEMENT OF ISSUES TO ACCOMPANY THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

As of the Final Office Action, claims 44-82 were pending. In the Final Action mailed November 2, 2006, claims 44-80 were finally rejected as unpatentable under 35 U.S.C. §103(a). The Examiner failed to address claims 81 and 82 in either one of the Office Action Summary or the Detailed Action.

Applicant incorporates all of the arguments previously set forth in prior Responses filed and provides here a mere concise summary of certain clear errors committed by the Examiner. At the least, the Examiner has committed clear error by (1) failing to address several claims at all, (2) failing to properly identify the primary reference relied upon in formulating the 103 rejection and (3) applying a clearly legally erroneous test for combining references in formulating the 103 rejection.

(1). On August 17, 2006, Applicant filed a response to the May 17, 2006 Non-Final Action in which claims 81 and 82 were added. See August 17, 2006 Response at pgs. 10-11, 19. The Final Office Action fails to acknowledge or address either one of claims 81 or 82. Having not properly addressed the claims, the Examiner has committed clear error by omitting "one or more essential elements needed for a prima facie rejection." See OG Notice July 12, 2005 entitled "New Pre-Appeal Brief Conference Pilot Program."

(2). The Examiner has also clearly erred by failing to properly identify the primary reference relied upon in formulating the 103 rejection, thus again omitting "one or more essential elements needed for a prima facie rejection." Specifically, in both the Non-Final Action mailed May 17, 2006 and the Final Action mailed November 2, 2006, the detailed action states that rejection is based on the Anandan publication US 2003/0021242. However, as pointed out by

Applicant on numerous occasions (*see, e.g.*, Response filed September 13, 2005 at 5 and Response filed August 17, 2006 at 12), the only Anandan publication cited by the Examiner in any Notice of References Cited is US 2002/0062251. (*See* Form PTO-892 dated January 11, 2005). Furthermore, only the 2002 publication remotely aligns with the paragraphs of the publication relied upon in the detailed action.

The Examiner's continued proliferation of referring to the wrong reference despite Applicant's attempt to direct the Examiner to cite the apparent proper reference, raises the question of what reference the Examiner truly does intend to rely upon. If the Examiner truly intends to refer to the 2003 publication, as repeatedly referenced in numerous different Office Actions, the rejections are clearly erroneous as non-sensical, failing to match up in any way to the paragraphs of the reference allegedly relied upon in the detailed action. If the Examiner actually intends to refer to the 2002 publication, as appears to be the case, then the rejection is clearly erroneous for improperly citing the wrong reference as well as for the reasons set forth below about improper motivation to combine.

(3). The Examiner has further committed clear error by failing to show proper motivation to combine the Anandan and Herrod references in making the obviousness rejection by relying upon a clearly legally erroneous basis. Specifically, the Examiner stated that the combination of the two references is "not improper" because the references' "inventions are in the same environment and complement each other." Final Action of November 2, 2006 at page 11. The Examiner provides no reference to any portion of the MPEP or to any case law that stands for the proposition that the proper test for combining references is whether they "are in the same environment" and "complement[ary]" to one another. Indeed, the Examiner fails to even define what is meant by these phrases. Thus, the Examiner has failed to show a proper

motivation to combine the references and has thereby committed clear error. Absent a motivation to combine, a prima facie case of obviousness has not been shown. Because the Anandan and Herrod references are not properly combined and are the only references applied against the claims in the Office Action, all pending claims should be allowed.

CONCLUSION

The Examiner has committed clear error by failing to address several claims at all, failing to properly identify the primary reference relied upon in formulating the 103 rejection and applying a clearly legally erroneous test for combining references.

Applicants respectfully request that the Panel withdraw the Final Rejection and allow the Application.

The Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from, or credit any overpayments to, the undersigned's Deposit Account No. 50-1059.

Date: February 2, 2007

Respectfully submitted,

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